do not appear to be applicable to the current application. Applicant notes that these cases were not cited because they have anything to do with software development but because they illustrate basic principles of determining obviousness.

For example, the Federal Circuit has stated that "[o]bviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination." See *In re Geiger, 815 F.2d 686, 2 U.S.P.Q. 2d 1276,1278 (Fed. Cir. 1987).* This principle applies to all determinations of obviousness including software development.

As stated by the Federal Circuit:

> It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fritch, 972 F.2d 1260,23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992) (quoting In re Fine, 837 F.2d 1071,1075, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988)).

Applicant believes these principles are directly on point to the rejection of the claims of the present application. Particularly, the references cited in the rejection of the present claims, Touboul, Hodges and Dunn, do not in combination teach the subject matter set out in the claims of present application. That is, a person of ordinary skill in the art would not read these references and as a result be motivated to construct the subject matter set out in Applicant's claims. Rather, the motivations for the combinations

suggested by Examiner reside in Applicant's specification and not in the cited references.

Response to Second Point:

Examiner has quoted *In re McLaughlin* as stating that hindsight reasoning may be used as long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure.

However, this is exactly the point Applicant is making. For example, Examiner argues the following:

> It would have been obvious to one of ordinary skill in the art at the time of invention to implement Touboul's agents with software updating as found in Hodges' teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to shift useful functionality to an automated agent in order to decrease burden on the network administration. In the case of virus prevention software of Hodges, this means the user and the network administration are required to do less yet maintain an acceptable level of virus protection.

See the Office Action dated July 2, 2003 at page 2, line 22 through page 3, line 4.

In the above statement by Examiner, the given motivation for the combination suggested by Examiner comes from Applicant's disclosure, not from the cited art.

For example, where in Touboul, Hodges or Dunn does it teach that it would be desirable "to shift useful functionality to an automated agent in

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order to decrease burden on the network administration"? None of the cited references teach that there is any need to decrease burden on the network administration. None of the cited references teach that if there were a burden on the network administration the way to alleviate the burden would be to shift useful functionality to an automated agent. This information is available from a reading of Applicant's disclosure. This information is not available from reading the cited references. Examiner, then, has performed improper reconstruction because Examiner has used knowledge gleaned only from applicant's disclosure.

Response to Third Point:

Examiner and Applicant appear to agree that obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation found in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

As discussed above, Applicant does not believe there is any teaching, suggestion or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the art to make the combinations suggested by Examiner.

Examiner has failed to show that any reference or knowledge generally available in the art recognized the need to (or desirability of) decreasing the burden on the network administration. Examiner has failed to show that any reference or knowledge generally available in the art

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recognized that any burden on the network administration could be alleviated by shifting useful functionality to an automated agent residing within a managed computer. Rather, Examiner has merely used Applicant's teaching on these issues as the motivation for making the suggested combinations.

Response to Fourth Point:

Examiner has argued that "automatic discovery of agents" does not overcome "self installation". This seems to be misunderstanding of the point.

In Touboul, a system controlling a plurality of workstations "discovers" agents on managed workstations. This is a fundamental part of the invention of Touboul.

In claim 1 of the present case, the managing computer does not "discover" an agent on a managed computer. Rather, the managing computer forwards an agent to the managed computer. The agent is not an existing agent that is "discovered", but a new agent that is "sent".

Discovering an existing agent on a managed computer is significantly different then sending an agent to a managed computer.

Examiner has suggested that in light of Dunn, it would be obvious to modify Touboul so that agents are sent to managed workstations. Applicant's point is that Examiner has suggested modifying Touboul so that new agents are now "sent" rather than existing agents on workstations being "discovered". This modification would result in destroying subject matter within Touboul on which the invention of Touboul is based. Such a

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modification of a reference which results in destroying that on which the invention of the reference is based should not serve as a foundation for a rejection under 35 U.S.C. § 103. See, for example, *Ex parte Hartmann*, 186 U.S.P.Q. 366, 367 (PTO Bd. App. 1974).

Reiteration of Reasons for Traversal of the Claims Rejection

Examiner has rejected claims 1 through 7 and 9 through 21 under 35 U.S.C. § 103(a) as being unpatentable over USPN 6125,390 (Touboul) in view of USPN 6.035,423 (Hodges) and in further view of USPN 5,822,543 (Dunn). Applicant respectfully traverses the rejection.

Touboul

Touboul discloses a method and apparatus for monitoring and controlling in a network. The objects of the invention disclosed within Touboul include providing a network maintenance system which can identify failures of programs running on network workstations and take the appropriate corrective action to correct the problems that led to those failures and include providing a system which can correct problems on workstations within the S network by sending procedures to agents active on the workstations, each procedure consisting of one or more actions to be taken. See column 1, line 61 through column 2, line 3.

Hodges

Hodges discloses a method and system for providing automated updating and upgrading of antivirus applications using a computer network.

Dunn

Dunn discloses the gathering of data handling statistics in non-synchronous data communication networks. Dunn indicates that a timing script could be provided in a preselected script language and transmitted along with an "applet" (mini-application) that: self installs at the client station; then executes automatically without dependence upon any program resident at that station; and ultimately is discarded after the associated data is discarded by the client station. See column 8, lines 42 through 48.

Criteria for Rejection under 35 U.S.C. § 103(a)

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. Specifically three basic criteria must be met.

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP 706.02 (j).

Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness for the claims extant in the present case because there is no

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings as suggested by the Examiner.

Discussion of Independent Claim 1

Claim 1 sets out a method by which a managing computer manages applications residing on a managed computer. In step (a), an agent from the managing computer is forwarded to the managed computer. The agent, upon arriving at the managed computer, installs itself on the managed computer and maintains specified applications residing on the managed computer. The maintenance includes making updates to the specified applications when new versions of the specified applications are available on the managing computer.

Examiner has argued that various parts of claim 1 are disclosed in three references.

Examiner asserts Touboul discloses a managing computer managing applications residing on a managed computer, but does not teach an agent, upon arriving at the managed computer, installing itself on the managed computer and maintaining specified applications residing on the managed computer. Touboul also does not teach that maintenance includes making updates to the specified applications when new versions of the specified applications are available on the managing computer.

Examiner asserts that Hodges discloses maintaining software and making updates as necessary. Examiner however indicates that neither

Touboul nor Hodges discloses forwarding an agent from a managing computer to a managed computer, and neither reference discloses the agent installing itself on the managed computer.

Examiner asserts that Dunn discloses the ability of code to self install.

Piecemeal Reconstruction of Claims Does Not Show Obviousness

In essence, Examiner has attempted to, in a piecemeal fashion, reconstruct the limitations of claim 1. That is, Examiner has asserted Touboul discloses a managing computer managing applications residing on a managed computer, Hodges discloses maintaining software and making updates as necessary, Dunn discloses the ability of code to self install. Using claim 1 as a framework, a person of skill in the art could combine these selected teachings from these references into something similar to the subject matter set out in claim 1.

However, piecemeal reconstruction of prior art patents in the light of an applicant's disclosure is not a basis for a holding of obviousness under 35 U.S.C. § 103. *In re Kamm and Young*, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972). It is impermissible to use the claims as a frame and the prior-art references as a mosaic to piece together a facsimile of the claimed invention. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q. 2d 1434 (Fed. Cir. 1988).

In order to show obviousness, Examiner must provide sufficient a suggestion in the prior art (not in Applicant's Specification) for any suggested combination. Specifically, for a rejection under 35 U.S.C. § 103, the prior art

must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification, to make the necessary changes in the reference device. See *Ex parte Chicago Rawhide Manufacturing Co.*, 226 U.S.P.Q. 438 (PTO Bd. App. 1984). The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. See *In re Newell*, 891 F.2d 899, 12 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1989). Both the suggestion and the expectation of success must be found in the prior art, not in the Appellant's disclosure. *In re Dow Chemical Col.*, 837 F.2d 469, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988).

Not Obvious to Combine Touboul and Hodges

As discussed above, Examiner has argued that one of ordinary skill in the art would be motivated to shift useful functionality to an automated agent in order to decrease burden on the network administration. However, Examiner has failed to cite any art where this is taught or suggested. Neither Touboul nor Hodges teach that it would be desirable "to shift useful functionality to an automated agent in order to decrease burden on the network administration". Neither Touboul nor Hodges teach there is any need to decrease burden on the network administration. Neither Touboul nor Hodges teach that if there were a burden on the network administration the way to alleviate the burden would be to shift useful functionality to an automated agent. This information is available only from a reading of Applicant's disclosure. As discussed above, it is an improper reconstruction

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when the motivation to combine references is available only from knowledge gleaned from Applicant's disclosure.

Not Obvious to Combine Touboul and Dunn

Examiner's stated rationale for combination of the Touboul and Dunn does not show obviousness. Specifically, Examiner has argued that it would be obvious to implement Touboul's agent software with "self installation" and being sent from the managing computer as found in Dunn's teaching as a person of ordinary skill in the art would be motivated to make use of software which is self-contained and self reliant.

However, this would not be an obvious modification to Touboul's agent software as it would have the effect of destroying the invention upon which Touboul is based.

The courts have indicated that a modification of a reference which results in destroying that on which the invention of the reference is based should not serve as a foundation for a rejection under 35 U.S.C. § 103. See, for example, *Ex parte Hartmann*, 186 U.S.P.Q. 366, 367 (PTO Bd. App. 1974).

Touboul specifically states that it is an object of his invention to provide a system which allows automatic discovery of agents. See, for example, column 2, lines 16, 17. Automatic discovery of agents is also an element of claims 2, 3, 5, 6, 9 and 10.

Modifying Touboul as suggested by Examiner, to implement Touboul's agent software with "self installation" and being sent from the managing computer as found in Dunn's teaching would effectively destroy

the basis for automatic discovery of agents in Touboul. This is because, the modification suggested by Examiner would result in new agents being sent to a managed workstation rather than existing agents being discovered on a managed workstation. Such a modification of Touboul as suggested by Examiner would have the effect of destroying the invention (e.g., discovering existing agents on workstations) upon which Touboul is based. This is not an obvious modification of Touboul.

Independent Claim 11

Independent claim 11 sets out an agent running on a managed computer managed by a managing computer. The agent includes an integrity sensor, an action sensor and a main engine.

The integrity sensor monitors integrity of specified applications within the managed computer to ascertain when repair is needed. This functionality is not disclosed or suggested by the cited references. Touboul, for example, discusses an administrator attaching one or more triggers to cause an action to be taken. See column 8, lines 43 through 52. However, nothing in Touboul discloses or suggests that an agent includes an integrity sensor that monitors integrity of a specified applications within the managed computer to ascertain when repair is needed.

The main engine maintains the specified applications, wherein maintaining the specified applications includes making updates to the specified applications when new versions of the specified applications are available on the managing computer. This is not disclosed or suggested by

the cited references. As discussed above, the combination of the cited references suggested by Examiner does not disclose or suggest a main engine within an agent that makes updates to specified applications when new versions of the specified applications are available on a managing computer.

Independent Claim 17

Independent claim 17 sets out storage media that stores programming code which when run implements an agent running on a managed computer managed by a managing computer. The agent includes an integrity sensor, an action sensor and a main engine. This is not disclosed or suggested by the cited prior art.

Examiner has rejected claims 17 under the same rationale as claim 11, however, as discussed above, the elements of claim 17 are not disclosed or suggested by the cited prior art.

Particularly, the integrity sensor monitors integrity of specified applications within the managed computer to ascertain when repair is needed. This functionality is not disclosed or suggested by the cited references. Touboul, for example, discusses an administrator attaching one or more triggers to cause an action to be taken. See column 8, lines 43 through 52. However, nothing in Touboul discloses or suggests that an agent includes an integrity sensor that monitors integrity of a specified applications within the managed computer to ascertain when repair is needed.
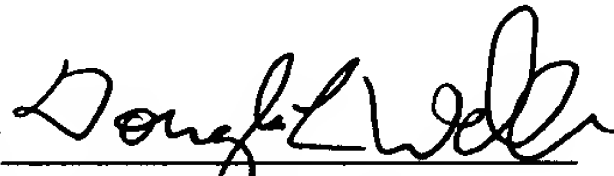
The main engine maintains the specified applications, wherein maintaining the specified applications includes making updates to the

specified applications when new versions of the specified applications are available on the managing computer. This is not disclosed or suggested by the cited references. As discussed above, the combination of the cited references suggested by Examiner does not disclose or suggest a main engine within an agent that makes updates to specified applications when new versions of the specified applications are available on a managing computer.

Conclusion

Applicant believes that the present case is in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,
HUEY LY

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